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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,287	06/13/2007	Magnus Flett	DEP5280USPCT	2336

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PHILIP S. JOHNSON  
JOHNSON & JOHNSON  
ONE JOHNSON & JOHNSON PLAZA  
NEW BRUNSWICK, NJ 08933-7003

EXAMINER
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WAGGLE, JR, LARRY E

ART UNIT	PAPER NUMBER
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3775

NOTIFICATION DATE	DELIVERY MODE
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08/19/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jnjuspatent@corus.jnj.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/598,287	<b>Applicant(s)</b> FLETT ET AL.	
	<b>Examiner</b> Larry E. Waggle, Jr	<b>Art Unit</b> 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 41-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 41-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>23 Aug 2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “440” has been used to designate both a “step” in flowchart 430 and a “CAS system” and “444” has been used to designate both a “loop” in flowchart 430 and a “trackable marker.” Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 302, as disclosed on page 11, line 21. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New

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Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 450, as shown in Figure 9. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informality:

On page 20, line 13, it appears there are some extraneous question marks (i.e. ??) in the sentence.

Appropriate correction is required.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

Claims 42 and 44-47 are dependent upon cancelled claims and thus are considered incomplete. As such, these claims have not been further treated on the merits thereof. See MPEP 608.01(n)

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6 and 9-10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitations "the first carriage" and "the second carriage." There is insufficient antecedent basis for these limitations in the claim.

Claim 9 recites the limitations "the first pair of opposed sides," "the second pair of opposed sides," "the third carriage" and "the fourth carriage." There is insufficient antecedent basis for these limitations in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

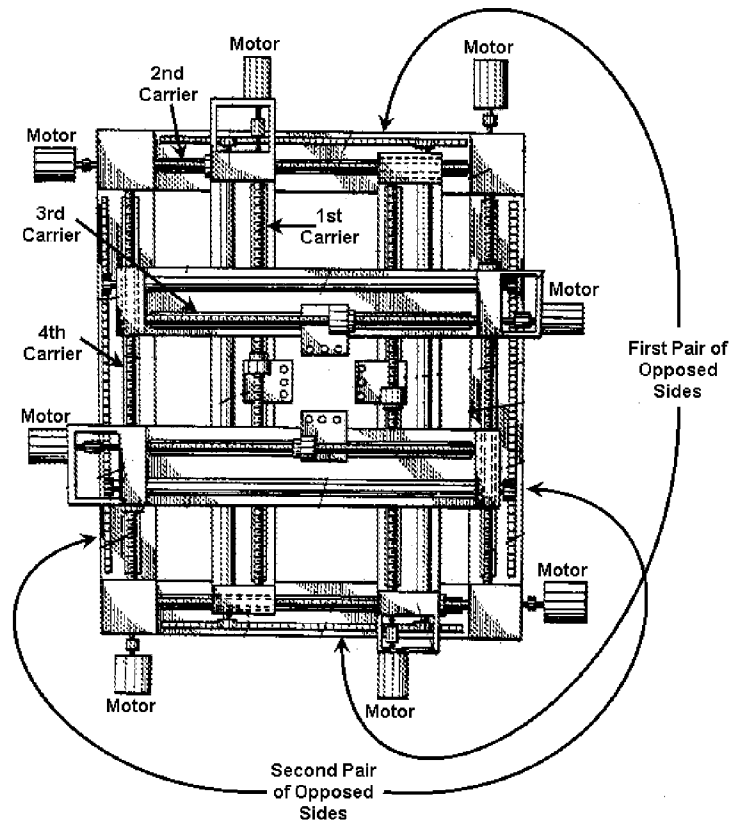
This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-5, 7-8, 11-14 and 43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagisawa (US Patent 5,311,790) in view of Yanagisawa (US Patent 4,995,277).

Yanagisawa '790' discloses a jig (Figure 6) comprising a support frame (320); a first guide member (302) mounted on the support frame via a first arm (i.e. element connecting 306 and 318) and translatable (i.e. by drive mechanisms / 1<sup>st</sup> and 2<sup>nd</sup> carriers / lead screw) over a first plane (i.e. defined by movement of 302 in both the X and Y directions); and a second guide element (324) mounted on the support frame via a second arm (i.e. element connecting 328 and 340) and translatable (i.e. by drive mechanisms / 3<sup>rd</sup> and 4<sup>th</sup> carriers / lead screw) over a second plane (i.e. i.e. defined by movement of 324 in both the X and Y directions) parallel to the first plane, wherein each guide element is independently driven by an electric motor (i.e. similar to 8b in Figure 1)

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and the support includes a first pair of opposed sides, each including a slider (306 and 318), and a second pair of opposed sides perpendicular to the first pair, each including a slider (328 and 340) (see annotated Figure below and column 9, lines 7-45).



Yanagisawa '790' disclose that tools can be attached to the guide members (column 3, lines 8-10); however, fail to disclose the connection being first and second guide channels. Yanagisawa '277' teaches a jig (Figure 1) comprising a guide element (130) capable of having a guide channel (Figure 6 and column 4, lines 41-45). It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Yanagisawa '790' with the guide element capable of having a guide channel in view of Yanagisawa '277' in order to provide for the passing of a tool between the first and second guide elements.

With regard to the statements of intended use and other functional statements, such as “for,” they do not impose any structural limitations on the claims distinguishable over the invention of Yanagisawa ‘790’ in view of Yanagisawa ‘277’ which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

**Claims 1-10, 12-14 and 43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagisawa (US Patent 4,995,277) in view of Yanagisawa (US Patent 5,311,790).

Yanagisawa discloses a jig (Figure 1) comprising a support frame (10); a first guide element (130) capable of having a first guide channel (Figure 6 and column 4, lines 41-45) mounted on the support frame via a first arm (94 or 96) and translatable (i.e. by drive mechanisms / carrier / lead screws (12, 14, 26 and 28) including 1<sup>st</sup> and 2<sup>nd</sup> carriers (92 and 98) bearing the first guide element) over a first plane (i.e. defined by movement of 130 in both the X and Y directions), wherein the guide element is independently driven by an electric motor (40 and 62) in the X and Y directions and the support includes a first pair of opposed sides (i.e. top and bottom sides in Figure 1),



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each including a slider (84 and 86), each slider having a guide track (106 and 108) having a bushing (114) receiving an end of the carrier, and a second pair of opposed sides (i.e. left and right sides in Figure 1) perpendicular to the first pair, each including a slider (88 and 90), each slider having a guide track (106 and 108) having a bushing (114) receiving an end of the carrier, wherein the first carrier extends between the sliders of the first pair of sides and the second carrier extends between the sliders of the second pair of sides (column 2, line 26 – column 5, line 25).

Yanagisawa '277' discloses the claimed invention except for a second guide element having a second guide channel mounted on the support frame via a second arm and translatable by a drive mechanism including 3<sup>rd</sup> and 4<sup>th</sup> carriers bearing the second guide element over a second plane parallel to the first plane, wherein the guide element is independently driven by an electric motor, the 3<sup>rd</sup> carrier extends between sliders on the first pair of slides and the 4<sup>th</sup> carrier extends between sliders on the second pair of sides. Yanagisawa '790' teaches a jig (Figure 6) wherein a first guide element (302) is mounted on a support frame (302) and is translatable (i.e. by a drive mechanism) over a first plane (i.e. defined by movement of 302 in both the X and Y directions); and a second guide element (324) is mounted on the support frame and translatable (i.e. by a drive mechanism) over a second plane (i.e. i.e. defined by movement of 324 in both the X and Y directions) parallel to the first plane. A skilled artisan would recognize that a duplication of the essential working parts (i.e. Figure 1 of Yanagisawa '277') would yield a device similar to that of Yanagisawa '790', where it has been held that mere duplication of the essential working parts of a device involves only

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routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. This would result in the invention of Yanagisawa '277' including a second guide element having a second guide channel mounted on the support frame via a second arm and translatable by a drive mechanism including 3<sup>rd</sup> and 4<sup>th</sup> carriers bearing the second guide element over a second plane parallel to the first plane, wherein the guide element is independently driven by an electric motor, the 3<sup>rd</sup> carrier extends between sliders on the first pair of slides and the 4<sup>th</sup> carrier extends between sliders on the second pair of slides. It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Yanagisawa '277' with duplicating its essential working parts to yield a device in view of Yanagisawa '790' in order to provide a device comprising two guide elements independently translatable with respect to each other over two parallel planes.

With regard to the statements of intended use and other functional statements, such as "for," they do not impose any structural limitations on the claims distinguishable over the invention of Yanagisawa '277' in view of Yanagisawa '790' which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the

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claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

**Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagisawa (US Patent 4,995,277) in view of Yanagisawa (US Patent 5,311,790) further in view of Yau (US Patent 6,196,081).

Yanagisawa '277' in view of Yanagisawa '790' disclose the claimed invention except for each motor being a stepper motor. Yau teach the use of stepper motors (30) to adjust the position of a first guide member (24) relative to a second guide member (18) (Figure 1 and column 3, line 26 – column 5, line 12). It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Yanagisawa '277' in view of Yanagisawa '790' with the use of stepper motors to adjust the position of the first guide member relative to the second guide member in view of Yau in order to provide a precise and controlled movement of the guide elements without the use of positive feedback.

**Claims 16-18 and 41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagisawa (US Patent 4,995,277) in view of Yanagisawa (US Patent 5,311,790) further in view of Henderson et al. (US Patent 7,217,276).

Yanagisawa '277' in view of Yanagisawa '790' disclose the claimed invention except for the jig further comprising a plurality of feet engageable with a surface of a body part, a first marker attached to an instrument and a second marker attached to the second guide element, wherein the markers are detectable by a tracking system. Henderson et al. teach a jig (110) comprising a plurality of feet (422) engageable with a

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surface of a body part (120), a first marker (122) attached to a instrument (114) and a second marker (144) attached to a guide element (140), wherein the markers are detectable by a tracking system (126) (Figures 1 and 4A and column 3, line 35 – column 9, line 50). It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Yanagisawa '277' in view of Yanagisawa '790' with the jig comprising a plurality of feet engageable with a surface of a body part, a first marker attached to a instrument and a second marker attached to a guide element, wherein the markers are detectable by a tracking system in view of Henderson et al. in order to provide a tracking and guiding means for positioning an instrument with respect to a body part.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Challis (US Patent 4,865,496) discloses a jig comprising a support and first and second guide elements.**

**Mazzocchi et al. (US Publication 2004/0167543) discloses a jig comprising a support frame and first and second guide elements.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry E. Waggle, Jr whose telephone number is (571)270-7110. The examiner can normally be reached on Monday through Thursday, 6:30 a.m. to 5:00 p.m. EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. Barrett can be reached on (571)272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. E. W./  
Examiner, Art Unit 3775

/Thomas C. Barrett/  
Supervisory Patent Examiner, Art  
Unit 3775